PATENT

Atty Docket No.: 200208213-1
App. Ser. No.: 10/628,291

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-39 are pending, of which claims 1, 19, 29, and 33 are independent.

Claim 1, 7, 11, 13, and 18 were rejected under nonstatutory double patenting as allegedly being unpatentable over claims 1-45 of the issued '897 patent (6,813,897).

Claim 38 was rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite.

Claims 1-9, 11-14, 18, 19, 21-23, 27-36, and 38-39 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Budelman (5629608).

Claims 10, 20, 25, and 37 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Bavaro et al. (4,974,272).

Claim 15 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Lehr et al. (6,473,608).

The above rejections are respectfully traversed.

Allowable Subject Matter

The undersigned thanks the Examiner for indicating that claims 16, 17, 24, and 26 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

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Drawings

The undersigned thanks the Examiner for indicating that the drawings as filed on July 29, 2003 have been accepted.

Claim Rejections Under Nonstatutory Double Patenting

The test for a nonstatutory obviousness-type double patenting rejection is whether at least one examined application claim is not patentably distinct from the reference claim(s) because the former is either anticipated by or would have been obvious over the later, even though the two are not identical.

The Office Action indicated that application claims 1, 7, 11, 13, and 18 were rejected under nonstatutory double patenting as being unpatentable over claims 1-45 of the issued '897 patent (hereinafter, "issued claims"). Particularly, application claims 1, 19, 29, and 33 were allegedly rejected by the issued claims 1, 2, 4, and 12 of the issued '897 patent.

It is respectfully submitted that application claims 1, 19, 29, and 33 are related to operating a primary power supply at an efficient operating point *of the primary power supply*. In contrast, the claims in the issued '897 patent are related to supplying power to meet power demand based on an operating level threshold *of the cooling system component*, that is, *the load* (issued claims 1, 2, and 4). Although the issued claim 12 states generally that the operating level threshold is associated with an efficiency of a power system, there is no mention in the issued claims 1, 2, 4, and 12 of operating the primary power supply *at its efficient operating point*, as indicated in application claims 1, 19, 29, and 33.

The Office Action provided no details on the rejection of claims 7, 11, 13, and 18 under nonstatutory double patenting. Therefore, it is not clear how those application claims are rejected or which issued claims are used to reject such application claims.

Accordingly, it is respectfully submitted that the Office Action failed to establish a proper nonstatutory double patenting rejection, and withdrawal of such a rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. §112, Second Paragraph

Claim 38 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite because there allegedly should be a relationship established between "an output power of the primary power supply means" in lines 1-2 and "the output power of the primary power supply means" in line 5 to indicate whether they are the same or different. It is respectfully submitted that there is an inherent relationship between the two recitations, and they refer to the same claimed feature. Particularly, the initially recited "an output power of the primary power supply means" provides antecedent basis for the subsequently recited "*the* output power of the primary power supply means." Indeed, the language in claim 38 is based on one of the basic tenets of claim drafting to avoid a rejection under 35 U.S.C. §112, second paragraph for lack of antecedent basis in the first instance.

Accordingly, it is respectfully submitted that claim 38 satisfies the requirements under 35 U.S.C. §112, second paragraph, and withdrawal of this rejection is respectfully requested.

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Claim Rejections Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. §102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-9, 11-14, 18, 19, 21-23, 27-36, and 38-39 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Budelman (5629608).

Independent claims 1, 19, 29, and 33 all recite the use of a primary, or first, power supply and a secondary, or second, power supply. In contrast, Budelman teaches the use of a *single* power supply 410 with two voltage regulators 420 and 440. The voltage regulators 420 and 440 cannot be deemed power supplies, as alleged in the Office Action, because they merely regulate the voltage and current that is being supplied by the *single* power supply 410 without providing any additional power. As conventionally understood in the art, a power supply provides a finite and set amount of power. Thus, when there are two power supplies, as are claimed, a second power supply is inherently capable of providing power *in addition* to

the finite power provided by a first power supply. In contrast, as stated in Budelman, the voltage regulators 420 and 440 are parts of a voltage regulating device 400, wherein the second voltage regulator 440 with faster transient response is activated to help source current when the first voltage regulator 420 is unable to adequately respond to an increase in current demand from the system (when the corresponding output voltage falls). Thus, the second voltage regulator 440 merely provides another gateway for power (voltage × current) to reach the load 450. No additional power is provided by the second voltage regulator 440 because the total finite amount of power output to the load is governed by the finite amount of power output from the *single* power supply 410, which is divided up by the voltage regulators 420 and 440 differently at different times. The finite power output from the *single* power supply 410 is as evidence in Budelman, col. 4, ll. 35-58, which states that the falling of regulated output voltage indicates the need for additional current at the load, which can be provided by the second voltage regulator 440 (that is, P = VI; with P being constant, a drop in V is made up by an increase in I).

Because Budelman fails to disclose each and every claimed element as arranged in independent claims 1, 19, 29, and 33, it is respectfully submitted that claims 1-39 are allowable over the references of record. Accordingly, withdrawal of the rejection of these claims is requested.

Claim Rejections Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation,

> either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 10, 15, 20, 25, and 37 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Budelman in view of Bavaro et al. and Lehr et al.

It is respectfully submitted that, for at least the reasons set forth earlier, independent claims 1, 19, 29, and 33 are not anticipated by Budelman. In addition, the Office Action does not rely upon Bavaro et al. and Lehr et al. to make up for the deficiencies in Budelman with respect to claims 1, 19, 29, and 33. Accordingly, the Office Action failed to make a *prima facie* case of obviousness against claims 10, 15, 20, 25, and 37. Withdrawal of the rejection of these claims and their allowance are respectfully requested.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: April 12, 2006

By

Ashok K. Mannava
Registration No.: 45,301

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 880-5270 (facsimile)